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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/675,128
Filing Date: September 30, 2003
Appellant(s): MILOSAVLJEVIC, NADA

Richard Lazarus
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 2, 2011 appealing from the Office action mailed April 4, 2011.

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(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1, 7, 22, 24 – 25, 29 – 34, and 36 – 45

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

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(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

6047259	Campbell et al.	4-2000
6468210	Iliff	10-2002
2002/0172809	Tetrault	11-2002
2004/0078215	Dahlin et al.	4-2004
6632042	Chin et al.	10-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1, 7, and 32 - 34 are rejected under 35 U.S.C. 101 because Based upon consideration of all of the relevant factors with respect to the claim as a whole, claim(s) 1, 7, and 32 - 34 are held to claim an abstract idea, and is therefore rejected as ineligible subject matter under 35 U.S.C. § 101. In particular, the rationale for finding that claims 1, 7, and 32 - 34 are directed toward non-statutory subject matter include no recitation of a machine or transformation, either express or inherent. See *Bilski v. Kappos*, 95 USPQ2d 1001 (U.S. 2010)

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Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 7, 32, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell, herein after Campbell (U.S. Patent Number 6,047,259) in view of Iliff (U.S. Patent. No. 6,468,210) further in view of Tetrault (U.S. Publication Number 2002/0172809 A1).

With regard to claim 1 (Currently amended), Campbell teaches a method for facilitating the evaluation, diagnosis and treatment of a patient (column 2, lines 2 – 4), comprising the steps of:

(a) conducting a preliminary physical examination of the patient (column 7, lines 31 – 41) and making a preliminary diagnosis based on the preliminary physical examination that patient has a particular medical disorder (column 5, lines 48 – 51 and column 12, lines 48 – 55) where Campbell discloses a rule out list and tentative diagnosis;

(b) after the performance of step (a) obtaining a paper template having only one sheet of paper, the one sheet of paper having preprinted information listing signs or symptoms that might be exhibited by one afflicted with the particular medical disorder (column 4, lines 56 – 60) where a user can enter information through a keyboard and other input devices

and information listing other medical disorders that might be confused with the particular medical disorder (Figure 9; column 7, lines 42 – 48; and column 16, line 66 through column 17, line 22) where a rule out list is displayed (the rule out list consists of medical disorders with the same or similar signs or symptoms);

(c) after the performance of step (b) consulting the paper template for information prompting the user to further examine the patient for the signs or symptoms listed on the paper template (Figure 9;

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column 16, line 33 through column 17, line 37). Campbell does not disclose a paper template, however, this feature is disclosed by Tetrault and discussed below.

Iliff teaches a method comprising: (d) after the performance of step (c), conducting a further examination of the patient to determine whether the patient is exhibiting the signs or symptoms listed on the paper template and entering onto the paper template hand written information identifying those of the one or more signs or symptoms listed on the paper template that are exhibited by the patient (Figures 31, 32a, and 34; column 8, lines 5 – 19 where medical disorders are further defined by more specific symptoms). Iliff does not disclose a paper template, however, this feature is disclosed by Tetrault and discussed below.

Tetrault discloses a preprinted paper template which may be re-used time and again (paragraphs 13 – 17).

Claim 1 is rejected under 35 U.S.C. 103 as being unpatentable over Campbell in view of Iliff, further in view of Tetrault.

Campbell is directed to a software system for managing a health care practice which includes interactive software tools for conducting a physical exam, suggesting tentative diagnosis, and managing a treatment protocol.

Iliff is directed to a structure based processing which includes a method of diagnosing diseases that works by arranging diseases, symptoms, and questions into a set of related disease, symptom, and question structures, such as objects or lists.

Tetrault is directed to a method for producing a reusable plastic paper which is disposed a printed template, comprising an opaque plastic layer, printing on one or both surfaces, and sandwiching the printed layer between a first clear layer and a second clear layer.

It would have been obvious to one of ordinary skill in the art to include in the system of diagnosing a disease of Campbell the ability to generate lists of related symptoms as taught by Iliff with the re-usable template disclosed by Tetrault since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did

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separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

With regard to claim 7 (Previously Presented), Campbell, Iliff, and Tetrault teach the method of claim 1.

Iliff teaches a method further comprising the step of transmitting the information about the particular medical disorder, the predefined signs or symptoms exhibited by the patient and the patient data to another user or to the patient's medical record (column 5, lines 35 – 43).

The motivation to combine the teachings of Campbell and Iliff is discussed in the rejection of claim 1, and incorporated herein.

With regard to claim 32 (Currently Amended), Campbell, Iliff, and Tetrault teach the method of claim 1.

Iliff teaches a method further comprising the step of: (e) consulting the paper template for information prompting the user to conduct a differential diagnosis of the patient based on the information identifying other medical disorders that might be confused with the particular medical disorder (column 6, lines 11 – 23; column 49, lines 55 – 65; and, column 51, lines 2 – 15 where a differential diagnosis is performed to further identify the medical disorder of the patient).

Tetrault discloses a paper template (paragraphs 13 – 17).

The motivation to combine the teachings of Campbell, Iliff, and Tetrault is discussed in the rejection of claim 1, and incorporated herein.

With regard to claim 33 (Currently Amended), Campbell, Iliff, and Tetrault teach the method of claim 32. Campbell teaches a method further comprising the steps of:

(f) consulting the paper template for information prompting the user to conduct a work up of said patient, the work up comprising one or more predefined elements based on the information identifying the

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particular medical disorder (Figure 10 and column 17, lines 45 – 52 where recommended therapies are displayed based on the medical disorder selected).

Iliff discloses a method further comprising the step of (g) entering onto the paper template hand written information identifying those of the one or more predefined work up elements conducted on the patient (column 5, lines 10 – 21; column 9, lines 22 – 38; and column 10, lines 35 – 43 where laboratory tests and images can be performed to assist in the diagnosis of a medical disorder).

Tetrault discloses a paper template (paragraphs 13 – 17).

The motivation to combine the teachings of Campbell, Iliff, and Tetrault is discussed in the rejection of claim 1, and incorporated herein.

With regard to claim 34 (Currently Amended), Campbell, Iliff, and Tetrault teach the method of claim 33. Campbell teaches a method further comprising the steps of:

(h) consulting the paper template for information prompting the user to recommend a treatment plan for the patient (column 7, lines 42 – 56 where a treatment protocol is recommended based on a tentative diagnosis), the treatment plan comprising one or more predefined elements based on the information identifying the particular medical disorder (column 17, lines 53 – 60); and

(i) entering onto the paper template hand written information identifying those of the one or more predefined treatment plan elements recommended for the patient (column 2, lines 4 – 31).

Tetrault discloses a paper template (paragraphs 13 – 17).

The motivation to combine the teachings of Campbell, Iliff, and Tetrault is discussed in the rejection of claim 1, and incorporated herein.

5. Claims 22 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell, herein after Campbell (U.S. Patent Number 6,047,259) in view of Dahlin et al., herein after Dahlin (U.S. Pub. No. 2004/0078215 A1).

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With regard to claim 22 (Currently amended), Campbell teaches an apparatus for use in connection with providing health care to a patient suspected of having a medical disorder, comprising:

Preprinted information prompting the user to further examine the patient for one or more predefined signs and/or symptoms associated with the respective medical disorder (Figure 9 and column 2, lines 4 – 31) where prompts or reminders are displayed to guide a user through a medical exam to aid in selection of a tentative diagnosis (information may be preprinted on the computer screen as well as a sheet of paper) – preprinted information can be displayed on a computer monitor as well as on a sheet of paper;

Preprinted information prompting the user to recommend one or more predefined treatments that could be administered to treat the respective medical disorder (column 17, lines 46 – 55) where a treatment protocol is recommended to treat a tentative diagnosis;

at least one field for entry of patient data (Figure 4 and column 12, lines 13 – 18);

the user's observation that the patient exhibits one or more of the predefined signs and/or symptoms associated with the respective medical disorder (Figure 9; column 2, lines 4 – 31) where a user makes observations based on the examination and compares to predetermined observations;

the user's opinion that one or more of the predefined tests should be conducted to confirm that the patient is afflicted by the respective medical disorder (column 18, line 61 through column 19, line 52) where a therapy (treatment) screen is displayed which indicates products (i.e. medications) and services (interpreted as laboratory work or radiological images) to be performed; and

the user's opinion that one or more of the predefined treatments should be administered to treat the patient (column 18, line 61 through column 19, line 52) where a user can select a particular therapy to treat a patient.

Dahlin teaches an apparatus comprising:

a set of templates (Figures 3 – 19), each of the templates directed to a different medical disorder (paragraphs [0119] and [0124] where Dahlin discloses complain specific templates, thus different templates for different disorders), one of which medical disorders the patient has been preliminarily diagnosed as being afflicted with based on a preliminary physical examination of the patient (as taught by

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Campbell in figures 9 and 10 where different medical disorders are illustrated), each of the templates provided with:

Preprinted information prompting the user to conduct one or more predefined tests that could be used to determine the presence or severity of the respective medical disorder (paragraphs [0020], and [0093]);

wherein each of said templates is adapted for annotation by a user to indicate (paragraph [0105]):

Claim 22 is rejected under 35 U.S.C. 103 as being unpatentable over Campbell in view of Iliff, further in view of Dahlin.

Campbell is directed to a software system for managing a health care practice which includes interactive software tools for conducting a physical exam, suggesting tentative diagnosis, and managing a treatment protocol.

Dahlin is directed to a system and method for efficiently documenting medical findings that consist of both a problem and a location on or in the body, and further provides a method for documenting multiple problems in related body locations using a template of the human body on a computer.

It would have been obvious to one of ordinary skill in the art to include in the system of diagnosing a disease of Campbell the ability to use templates to locate the medical problems as taught by Dahlin since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Template claim 36 repeats the subject matter of claim 22. As the underlying process of claim 22 has been shown to be fully disclosed by the teachings of Campbell and Dahlin in the above rejections of claim 22; as such, this limitation (36) is rejected for the same reasons given above for claim 22 and incorporated herein.

6. Claims 24 – 25, 29 – 31, 38 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell, herein after Campbell (U.S. Patent Number 6,047,259) in view of Dahlin et al., herein

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after Dahlin (U.S. Pub. No. 2004/0078215 A1) further in view of Chin et al., hereinafter Chin (U.S. Patent Number 6,632,042).

In regard to claim 24 (Previously Presented), Campbell and Dahlin teach the apparatus of claim 22.

Chin teaches an apparatus wherein one of the templates can be removed from the set of templates without damaging the remaining templates (column 8, lines 8 – 14 and column 10, lines 51 – 56) where the templates enclosed in transparent plastic can be assembled in a 3 ring binder or other binding system.

Claim 24 is rejected under 35 U.S.C. 103 as being unpatentable over Campbell in view of Dahlin further in view of Chin.

Campbell is directed to a software system for managing a health care practice which includes interactive software tools for conducting a physical exam, suggesting tentative diagnosis, and managing a treatment protocol.

Dahlin is directed to a system and method for efficiently documenting medical findings that consist of both a problem and a location on or in the body, and further provides a method for documenting multiple problems in related body locations using a template of the human body on a computer.

Chin is directed to a printed sheet protector system with binders.

It would have been obvious to one of ordinary skill in the art to include in the system of diagnosing a disease of Campbell the ability to use templates to locate the medical problems as taught by Dahlin since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

With regard to claim 25 (Previously Presented), Campbell, Dahlin, and Chin teach the apparatus of claim 22. Dahlin teaches an apparatus wherein each of the templates is printed (paragraph [0124]), however, Dahlin fails to teach where the template is printed on paper encased in transparent plastic.

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Chin teaches an apparatus wherein each of said template is printed on paper encased within transparent plastic (Chin: column 3, lines 24 – 28).

The motivation to combine the teachings of Campbell, Dahlin, and Chin is discussed in the rejection of claim 22, and incorporated herein.

With regard to claim 29 (Previously Presented), Campbell, Dahlin, and Chin teach the apparatus of claim 22.

Chin teaches an apparatus wherein the set of templates is bound into a handbook (column 8, lines 8 – 14 and column 10, lines 51 – 56) where the templates enclosed in transparent plastic can be assembled in a 3 ring binder or other binding system.

The motivation to combine the teachings of Campbell, Dahlin, and Chin is discussed in the rejection of claim 22, and incorporated herein.

With regard to claim 30 (Previously Presented), Campbell, Dahlin, and Chin teach the apparatus of claim 22. Campbell teaches an apparatus wherein the apparatus further comprises one or more templates including reference data comprising normal values or value ranges for the one or more tests (Figure 5) where a user can indicate, for example, whether a patient's temperature is normal based on the range of subnormal through elevated.

With regard to claim 31 (Previously Presented), Campbell, Dahlin, and Chin teach the apparatus of claim 22.

Dahlin teaches an apparatus wherein the apparatus further comprises a vision chart (paragraphs [0118], [0119], and [0124]). Although Dahlin does not explicitly disclose a vision chart, it would be obvious to include a vision chart when a patient's chief complaint involves the eyes (i.e. blurred vision).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include an apparatus wherein the apparatus further comprises a vision chart as taught by Dahlin, within the method of Campbell and Chin, with the motivation of providing an electronic

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system for documenting the results of a physical examination and outputting a plurality of medical problems based on the examination (paragraph [0019]).

Template claims 38 and 44 repeats the subject matter of claim 25 and 24, respectively. As the underlying process of claims 25 and 24 have been shown to be fully disclosed by the teachings of Campbell, Dahlin, and Chin in the above rejections of claims 25 and 24; as such, these limitations (38 and 44) are rejected for the same reasons given above for claim 25 and incorporated herein.

7. Claims 37, 39 – 43 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell, herein after Campbell (U.S. Patent Number 6,047,259) in view of Dahlin et al., herein after Dahlin (U.S. Pub. No. 2004/0078215 A1) further in view of Tetrault (U.S. Publication Number 2002/0172809 A1).

With regard to claim 37 (new), Campbell, Dahlin, and Tetrault teach the template of claim 36.

Tetrault teaches a template wherein the paper template is of a size capable of being easily transported in a pocket of a typical laboratory coat of a health care practitioner (paragraphs 6, 7, 35, and 48).

Claim 37 is rejected under 35 U.S.C. 103 as being unpatentable over Campbell in view of Iliff, further in view of Tetrault.

Campbell is directed to a software system for managing a health care practice which includes interactive software tools for conducting a physical exam, suggesting tentative diagnosis, and managing a treatment protocol.

Dahlin is directed to a system and method for efficiently documenting medical findings that consist of both a problem and a location on or in the body, and further provides a method for documenting multiple problems in related body locations using a template of the human body on a computer.

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Tetrault is directed to a method for producing a reusable plastic paper which is disposed a printed template, comprising an opaque plastic layer, printing on one or both surfaces, and sandwiching the printed layer between a first clear layer and a second clear layer.

It would have been obvious to one of ordinary skill in the art to include in the system of diagnosing a disease of Campbell the ability to use templates to locate the medical problems as taught by Dahlin with the re-usable template disclosed by Tetrault since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

With regard to claim 39 (new), Campbell, Dahlin, and Tetrault teach the template of claim 38.

Tetrault teaches a template wherein the transparent plastic cover is adapted for being marked and having the marks wiped clean (paragraphs 13 – 17).

The motivation to combine the teachings of Campbell, Dahlin, and Tetrault is discussed in the rejection of claim 37 and incorporated herein.

With regard to claim 40 (new), Campbell, Dahlin, and Tetrault teach the template of claim 36.

Tetrault teaches a template wherein the paper template includes a title of the medical disorder, a field for patient identification data, descriptive information about the medical disorder relating to the etiology of the disorder, a list of signs and symptoms of the disorder; differential diagnoses for the disorder; a list of tests used to confirm or evaluate the disorder; a list of treatments for the disorder, and information of particular note about the disorder (paragraphs 13 – 17; and claim 33). Although the template disclosed by Tetrault does not include the patient identification, et al., this information is printed matter on a template and USPTO personnel need not give patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate. See *Lowry*, 32 F.3d 1583-84, 32 USPQ2d 1035; *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004).

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The motivation to combine the teachings of Campbell, Dahlin, and Tetrault is discussed in the rejection of claim 37 and incorporated herein.

With regard to claim 41 (new), Campbell, Dahlin, and Tetrault teach the template of claim 36.

Tetrault teaches a template wherein the paper template is a single page with a title of the medical disorder, a field for patient identification data, descriptive information about the medical disorder relating to the etiology of the disorder, a list of signs and symptoms of the disorder, differential diagnoses for the disorder, a list of treatments for the disorder and information of particular note about the disorder on one side of the page and with the opposite side of the page including a field for recording laboratory test results and signs determined from a physical examination of the patient, a field for recording medications that the patient is taking or receiving, and a field for recording additional notes, comments, or information relating to the disorder or the patient (paragraphs 13 – 17; and claim 33). Although the template disclosed by Tetrault does not include the medical disorder, et al., this information is printed matter on a template and USPTO personnel need not give patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate. See *Lowry*, 32 F.3d 1583-84, 32 USPQ2d 1035; *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004).

The motivation to combine the teachings of Campbell, Dahlin, and Tetrault is discussed in the rejection of claim 37 and incorporated herein.

With regard to claim 42 (new), Campbell, Dahlin, and Tetrault teach the template of claim 41.

Tetrault teaches a template wherein the opposite side also illustrates separation of signs and symptoms into groups that commonly occur together or are associated with a particular form of the disorder (paragraphs 13 – 17; and claim 33). Although the template disclosed by Tetrault does not include the separation of signs and symptoms, et al., this information is printed matter on a template and USPTO personnel need not give patentable weight to printed matter absent a new and unobvious

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functional relationship between the printed matter and the substrate. See *Lowry*, 32 F.3d 1583-84, 32 USPQ2d 1035; *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004).

The motivation to combine the teachings of Campbell, Dahlin, and Tetrault is discussed in the rejection of claim 37 and incorporated herein.

With regard to claim 43 (new), Campbell, Dahlin, and Tetrault teach the template of claim 41.

Tetrault teaches a template wherein the one side includes a section for listing follow-up procedures used for patients with the medical disorder and a section describing staging criteria used with the disorder (paragraphs 13 – 17; and claim 33). Although the template disclosed by Tetrault does not include the follow up section, et al., this information is printed matter on a template and USPTO personnel need not give patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate. See *Lowry*, 32 F.3d 1583-84, 32 USPQ2d 1035; *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004).

The motivation to combine the teachings of Campbell, Dahlin, and Tetrault is discussed in the rejection of claim 37 and incorporated herein.

With regard to claim 45 (new), Campbell, Dahlin, and Tetrault teach the template of claim 36.

Tetrault teaches a template in combination with a plurality of additional templates, the combination comprising a pad of a plurality of different templates (paragraphs 13 – 17; and claim 33). Although the template disclosed by Tetrault does not include the plurality of different templates, et al., this information is printed matter on a template and USPTO personnel need not give patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate. See *Lowry*, 32 F.3d 1583-84, 32 USPQ2d 1035; *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004).

The motivation to combine the teachings of Campbell, Dahlin, and Tetrault is discussed in the rejection of claim 37 and incorporated herein.

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(10) Response to Argument

In the appeal brief filed November 2, 2011, Appellant makes the following arguments:

- A. Claims 1, 7, and 32 – 34 recited statutory subject matter and the rejection thereof under 35 U.S.C. § 101 should be withdrawn.
 - 1. Whether or not a method claims recites a machine or transformation is not dispositive of whether the claim recites statutory subject matters.
 - 2. Under the USPTO's Guidelines for Determining Subject matter Eligibility for process Claims, claims 1, 7, and 32 – 34 recite statutory subject matter and not merely an abstract idea.
- B. The rejection of claims 1, 7, and 32 – 34 under 35 U.S.C. § 103 is improper and should be reversed because the cited references cannot be combined to yield the claimed invention.
 - 1. Claim 1 is patentable because the cited references do not teach or suggest the combination of elements recited therein.
 - 2. Claim 7 is patentable because the cited references do not teach or suggest the combination of elements recited therein.
 - 3. Claim 32 is patentable because the cited references do not teach or suggest the combination of elements recited therein.
 - 4. Claim 33 is patentable because the cited references do not teach or suggest the combination of elements recited therein.
 - 5. Claim 34 is patentable because the cited references do not teach or suggest the combination of elements recited therein.
- C. The rejection of claims 22 and 36 under 35 U.S.C. § 103 is improper and should be withdrawn.
 - 1. Claim 22 is patentable because the cited references do not teach or suggest the combination of elements recited therein.
 - 2. Claim 36 is patentable because the cited references do not teach or suggest the combination of elements recited therein.

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D. The rejection of claims 24 – 25, 29 – 31, 38, and 44 under 35 U.S.C. § 103 is improper and should be withdrawn.

1. Claim 24 is patentable because the cited references do not teach or suggest the combination of elements recited therein.
2. Claim 25 is patentable because the cited references do not teach or suggest the combination of elements recited therein.
3. Claim 29 is patentable because the cited references do not teach or suggest the combination of elements recited therein.
4. Claim 30 is patentable because the cited references do not teach or suggest the combination of elements recited therein.
5. Claim 31 is patentable because the cited references do not teach or suggest the combination of elements recited therein.
6. Claim 38 is patentable because the cited references do not teach or suggest the combination of elements recited therein.
7. Claim 44 is patentable because the cited references do not teach or suggest the combination of elements recited therein.

E. The rejection of claims 37, 39 - 43, and 45 under 35 U.S.C. § 103 is improper and should be withdrawn.

1. Claim 37 is patentable because the cited references do not teach or suggest the combination of elements recited therein.
2. Claim 39 is patentable because the cited references do not teach or suggest the combination of elements recited therein.
3. Claim 40 is patentable because the cited references do not teach or suggest the combination of elements recited therein.
4. Claim 41 is patentable because the cited references do not teach or suggest the combination of elements recited therein.

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5. Claim 42 – 43 are patentable because the cited references do not teach or suggest the combination of elements recited therein.
6. Claim 46 is patentable because the cited references do not teach or suggest the combination of elements recited therein.

Examiner will address Appellant's arguments in the sequence they appear in the brief.

Response to A:

A. The Appellant argues claims 1, 7, and 32 – 34 recite statutory subject matter and the rejection thereof under 35 U.S.C. § 101 should be withdrawn because the machine or transformation test is not the only test for determining whether the claimed subject matter is statutory. The Examiner respectfully disagrees. Claims 1, 7, and 32 – 34 are rejected under 35 U.S.C. 101 because, based upon consideration of all of the relevant factors with respect to the claim as a whole, the claim(s) are held to claim an abstract idea, and are therefore rejected as ineligible subject matter under 35 U.S.C. 101 (see: *Bilski v. Kappos*, 95 USPQ2d 1001 (U.S. 2010)). In particular, the rationale for finding that claim(s) are directed toward non-statutory subject matter include, among other: No recitation of a machine or transformation, either express or inherent; and/or Insufficient recitation of a machine or transformation: Involvement of machine or transformation, with the steps is merely nominally, insignificantly, or tangentially related to the performance of the steps, e.g., data gathering, or merely recites a field in which the method is intended to be applied; and, Article is merely a general concept where an article as merely a general concept includes, but is not limited to human behavior (e.g. following rules or instructions) and mental activity (e.g. forming a judgment, observation, evaluation or opinion).

Appellant's method steps in claim 1 fail to transform underlying subject matter to a different state or thing. Furthermore, the claims are not tied to another statutory class and can be performed without the use of a particular apparatus. For example, claim 1 teaches conducting a preliminary physical examination, obtaining a paper template, consulting the paper template, and conducting a further examination of the patient, but in no way is it clear as to how this is accomplished (such as,

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accomplished by a particular machine). Based upon not only this analysis but a consideration of factors as a whole (including but not limited to those above), the method steps are found to be directed to an abstract idea.

Dependent claim(s) 7 and 32 – 34 when analyzed as a whole are held to be patent ineligible under 35 U.S.C. 101 because the additional recited limitation(s) similarly fail(s) to establish that the claim(s) is/are not directed to an abstract idea.

1. The Appellant's arguments regarding whether or not a method claims recites a machine or transformation is not dispositive of whether the claim recites statutory subject matter is addressed in the above response the rejection of claims 1, 7, and 32 – 34 under 35 U.S.C. § 101.
2. The Appellant's arguments regarding for Determining Subject matter Eligibility Under the USPTO's Guidelines for process Claims, claims 1, 7, and 32 – 34 is addressed in the above response the rejection of claims 1, 7, and 32 – 34 under 35 U.S.C. § 101.

Response to B:

B. The Appellant argues the rejection of claims 1, 7, and 32 – 34 under 35 U.S.C. § 103 is improper and should be reversed because the cited references cannot be combined to yield the claimed invention. The Examiner response to the Appellant's arguments are listed below in numbers 1 – 5.

1. The Appellant argues claim 1 is patentable because the cited references do not teach or suggest the combination of elements recited therein, such as: Campbell involves only computer based steps and does not disclose or suggest the use of a paper template in any form; Tetrault does not disclose or suggest the reusable plastic paper discloses therein includes or could include pre-printed medical information or that the plastic paper could be used in performing any form of medical diagnostic methods as recited in claim 1; Tetrault does not teach or suggest that the pre-printed information could include signs or symptoms that might be exhibited by one afflicted with a particular medical disorder, or that the writing face could be used in connection with facilitating a medical diagnosis; the Examiner has not established why one skilled in the art

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would have combined the computer based system of Campbell with the plastic paper of Tetrault; Illiff does not teach or suggest conducting a further examination of the patient to determine whether the patient is exhibiting the signs or symptoms listed on the paper template, and does not teach or suggest entering onto the paper template hand written information identifying those of the one or more signs or symptoms listed on the paper template that are exhibited by the patient; and, the Examiner has failed to provide an articulated reasoning how Illiff's computerized medical diagnostic system could be used to modify Campbell to yield the foregoing steps of conducting and entering, and therefore has not supported the legal conclusion of obviousness. The Examiner respectfully disagrees.

With regard to the Appellant's argument that Campbell involves only computer based steps and does not disclose or suggest the use of a paper template in any form, the Examiner respectfully disagrees and submits Campbell discloses, in addition to a monitor, a computer typically includes an output device such as a printer or speaker (Figure 2 and column 4, line 67 through column 5, line 2). The graphical user interface comprises screens for displaying the output (column 13, lines 60 – 65). It is inherent that a screen displayed on a computer can be printed, including the listing of the signs and symptoms exhibited by a patient (as disclosed by Campbell in column 4, lines 56 – 60) may be printed.

With regard to the Appellant's argument that Tetrault does not disclose or suggest the reusable plastic paper discloses therein includes or could include pre-printed medical information or that the plastic paper could be used in performing any form of medical diagnostic methods as recited in claim 1, the Examiner respectfully disagrees and submits Tetrault discloses a reusable plastic paper in which is disposed a printed template (paragraph 13). A template may be pre-printed to advantageously provide a consistent framework for addressing specific tasks, procedures, and reports (paragraph 51 which is interpreted as providing a template to perform a medical evaluation or diagnosis). The template disclosed by Tetrault does not specifically disclose a medical template, however, the difference in the template disclosed by Tetrault and the

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Appellant appears to be the content of the template. The use of the template is the same regardless of the content by providing standardized reporting of information.

With regard to the Appellant's argument that Tetrault does not teach or suggest that the pre-printed information could include signs or symptoms that might be exhibited by one afflicted with a particular medical disorder, or that the writing face could be used in connection with facilitating a medical diagnosis, the Examiner respectfully disagrees and submits a template may be pre-printed to advantageously provide a consistent framework for addressing specific tasks, procedures, and reports by providing standardized reporting of information (paragraph 51). The template disclosed by Tetrault does not specifically disclose a medical template, however, the difference in the template disclosed by Tetrault and the Appellant appears to be the content of the template. The use of the template is the same regardless of the content.

With regard to the Appellant's argument that the Examiner has not established why one skilled in the art would have combined the computer based system of Campbell with the plastic paper of Tetrault, the Examiner respectfully disagrees. The Examiner submits Campbell is directed to a software system for managing a health care practice which includes interactive software tools for conducting a physical exam, suggesting tentative diagnosis, and managing a treatment protocol; and, Tetrault is directed to a method for producing a reusable plastic paper. It would be obvious to combine the teachings of Campbell electronic diagnosis with the template based system of Tetrault as the medical information from the interactive medical systems of Campbell and Iliff could obviously be printed out to provide a reusable template based on the disclosure of Tetrault and the information supplied by Campbell.

With regard to the Appellant's argument that Illiff does not teach or suggest conducting a further examination of the patient to determine whether the patient is exhibiting the signs or symptoms listed on the paper template, the Examiner respectfully submits Iliff discloses further defining a patient's disease into specific symptoms to build upon each other in evaluating a patient (column 8, lines 5 – 19) and as illustrated in Figure 31 and column 5, lines 21 - 43 where a

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list of diagnostic symptoms are presented based on a diagnosis and additionally provides alternative symptoms.

With regard to the Appellant's argument that the Examiner has failed to provide an articulated reasoning how Iliff's computerized medical diagnostic system could be used to modify Campbell to yield the foregoing steps of conducting and entering, and therefore has not supported the legal conclusion of obviousness, the Examiner respectfully submits in response to applicant's argument that there is no suggestion to combine the references and that the Office has not made a prima facie case of obviousness, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it has been clearly set forth above in the 35 U.S.C. 103(a) rejections of the claims that there is motivation for combining the references (Campbell in view of Iliff further in view of Tetrault) and therefore the Office takes the position that a prima facie case of obviousness has been made. For instance, Campbell is directed to a software system for managing a health care practice which includes interactive software tools for conducting a physical exam, suggesting tentative diagnosis, and managing a treatment protocol; Iliff is directed to a structure based processing which includes a method of diagnosing diseases that works by arranging diseases, symptoms, and questions into a set of related disease, symptom, and question structures, such as objects or lists; and, Tetrault is directed to a method for producing a reusable plastic paper which is disposed a printed template, comprising an opaque plastic layer, printing on one or both surfaces, and sandwiching the printed layer between a first clear layer and a second clear layer. It would be obvious to combine the teachings of Campbell and Iliff's electronic diagnosis with the template based system of Tetrault as the medical information from the interactive medical systems of Campbell and Iliff could obviously be

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printed out to provide a reusable template based on the disclosure of Tetrault and the information supplied by Campbell and Iliff.

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2. The Appellant argues claim 7 is patentable because the cited references do not teach or suggest the combination of elements recited therein. The Examiner respectfully disagrees. The Examiner submits that the response to the Appellant's argument has been addressed in the response above (Response to B; number 1).

3. The Appellant argues claim 32 is patentable because the cited references do not teach or suggest the combination of elements recited therein, particularly that Iliff does not in any way teach or suggest consulting a paper template. The Examiner respectfully disagrees. The Examiner submits that the response to the Appellant's argument has been addressed in the response above (Response to B; number 1).

4. The Appellant argues Claim 33 is patentable because the cited references do not teach or suggest the combination of elements recited therein, particularly that Campbell nor Iliff do not in any way teach or suggest consulting a paper template. The Examiner respectfully disagrees. The Examiner submits that the response to the Appellant's argument has been addressed in the response above (Response to B; number 1).

5. The Appellant argues Claim 34 is patentable because the cited references do not teach or suggest the combination of elements recited therein, particularly that Campbell provides no teaching or suggestion of consulting a paper template and no teaching or suggestion of entering handwritten information onto a paper template. The Examiner respectfully disagrees. The Examiner submits that the response to the Appellant's argument has been addressed in the response above (Response to B; number 1).

Response to C:

C. The Appellant argues the rejection of claims 22 and 36 under 35 U.S.C. § 103 is improper and should be withdrawn. The Examiner respectfully disagrees. The Examiner response to the Appellant's arguments are listed below in numbers 1 – 2.

1. With regard to claim 22, the Appellant argues neither Campbell, Iliff, nor Dahlin teach a "paper template". The Examiner respectfully disagrees and submits Campbell discloses, in

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addition to a monitor, a computer typically includes an output device such as a printer or speaker (Figure 2 and column 4, line 67 through column 5, line 2). The graphical user interface comprises screens for displaying the output (column 13, lines 60 – 65). It is inherent that a screen displayed on a computer can be printed, including the listing of the signs and symptoms exhibited by a patient (as disclosed by Campbell in column 4, lines 56 – 60) may be printed. Dahlin discloses a system and method for efficiently documenting medical findings that consist of both a problem and a location on or in the body, and further provides a method for documenting multiple problems in related body locations using a template of the human body on a computer (Abstract; Figure 5; and, paragraph 20).

2. The Appellant argues claim 36 is patentable because the cited references do not teach or suggest the combination of elements recited therein, particularly the references do not teach a "paper template". The Examiner respectfully disagrees and submits that the response to the Appellant's argument has been address above in the Response to C, number 1.

Response to D:

D. The Appellant argues the rejection of claims 24 – 25, 29 – 31, 38, and 44 under 35 U.S.C. § 103 is improper and should be withdrawn. The Examiner respectfully disagrees. The Examiner response to the Appellant's arguments are listed below in numbers 1 – 7.

1. The Appellant argues claim 24 is patentable because the cited references do not teach or suggest the combination of elements recited therein, particularly Campbell, Dahlin or Chin teach or suggest removable paper templates, thus the Examiner failed to establish a *prima facie* case of obviousness. The Examiner respectfully disagrees. In response to applicant's argument that there is no suggestion to combine the references and that the Office has not made a *prima facie* case of obviousness, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re*

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Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it has been clearly set forth above in the 35 U.S.C. 103(a) rejections of the claims that there is motivation for combining the references (Campbell in view of Dahlin, further in view of Chin) and therefore the Office takes the position that a prima facie case of obviousness has been made. For instance, Campbell discloses, in addition to a monitor, a computer typically includes an output device such as a printer or speaker (Figure 2 and column 4, line 67 through column 5, line 2). The graphical user interface comprises screens for displaying the output (column 13, lines 60 – 65). It is inherent that a screen displayed on a computer can be printed, including the listing of the signs and symptoms exhibited by a patient (as disclosed by Campbell in column 4, lines 56 – 60) may be printed. Thus it would be obvious to combine the printed evaluation form disclosed by Campbell with the binder system of Chin to manage and organize the templates.

2. The Appellant argues claim 25 is patentable because the cited references do not teach or suggest the combination of elements recited therein, particularly “paper templates”. The Examiner respectfully disagrees and submits that the response to the Appellant’s argument has been address above in the Response to D, number 1.

3. The Appellant argues claim 29 is patentable because the cited references do not teach or suggest the combination of elements recited therein. The Examiner respectfully disagrees and submits that the response to the Appellant’s argument has been address above in the Response to C, number 1.

4. The Appellant argues claim 30 is patentable because the cited references do not teach or suggest the combination of elements recited therein, particularly the failure to disclose the apparatus comprises one or more templates including reference data comprising normal values or value ranges. The Examiner respectfully disagrees. In response to applicant's argument that there is no suggestion to combine the references and that the Office has not made a prima facie case of obviousness, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where

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there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it has been clearly set forth above in the 35 U.S.C. 103(a) rejections of the claims that there is motivation for combining the references (Campbell in view of Dahlin, further in view of Chin) and therefore the Office takes the position that a prima facie case of obviousness has been made. Campbell discloses (Figure 5) where a user can indicate, for example, whether a patient's temperature is normal based on the range of subnormal through elevated, thus indicating reference values.

5. The Appellant argues claim 31 is patentable because the cited references do not teach or suggest the combination of elements recited therein. The Examiner respectfully disagrees and submits that the response to the Appellant's argument has been address above in the Response to C, number 1.

6. The Appellant argues claim 38 is patentable because the cited references do not teach or suggest the combination of elements recited therein, particularly a single sheet of paper in a transparent cover, thus failing to establish a *prima facie* case of obviousness. The Examiner disagrees. In response to applicant's argument that there is no suggestion to combine the references and that the Office has not made a prima facie case of obviousness, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it has been clearly set forth above in the 35 U.S.C. 103(a) rejections of the claims that there is motivation for combining the references (Campbell in view of Dahlin, further in view of Chin) and therefore the Office takes the position that a prima facie case of obviousness has been made. For instance, Chin discloses where the templates enclosed in transparent plastic can be assembled

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in a 3 ring binder or other binding system. (column 8, lines 8 – 14 and column 10, lines 51 – 56) thus implying a single sheet of paper in a binder.

7. The Appellant argues claim 44 is patentable because the cited references do not teach or suggest the combination of elements recited therein, particularly a pad comprising a plurality of the same paper templates, thus failing to establish a *prima facie* case of obviousness. The Examiner disagrees. The Examiner respectfully disagrees and submits that the response to the Appellant's argument has been address above in the Response to D, number 5.

Response to E:

E. The Appellant argues the rejection of claims 37, 39 - 43, and 45 under 35 U.S.C. § 103 is improper and should be withdrawn. The Examiner respectfully disagrees. The Examiner response to the Appellant's arguments are listed below in numbers 1 – 6.

1. The Appellant argues claim 37 is patentable because the cited references do not teach or suggest the combination of elements recited therein, particularly how Tetrault's note paper is useful with the computer system of Campbell or Dahlin, thus failing to establish a *prima facie* case of obviousness. The Examiner disagrees. In response to applicant's argument that there is no suggestion to combine the references and that the Office has not made a *prima facie* case of obviousness, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it has been clearly set forth above in the 35 U.S.C. 103(a) rejections of the claims that there is motivation for combining the references (Campbell in view of Dahlin, further in view of Tetrault) and therefore the Office takes the position that a *prima facie* case of obviousness has been made. For instance, Tetrault discloses a reusable plastic paper in which is disposed a printed template (paragraph 13). A template may be pre-printed to advantageously

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provide a consistent framework for addressing specific tasks, procedures, and reports (paragraph 51 which is interpreted as providing a template to perform a medical evaluation or diagnosis).

The template disclosed by Tetrault does not specifically disclose a medical template, however, the difference in the template disclosed by Tetrault and the Appellant appears to be the content of the template. The use of the template is the same regardless of the content by providing standardized reporting of information.

2. The Appellant argues claim 39 is patentable because the cited references do not teach or suggest the combination of elements recited therein. The Examiner respectfully disagrees and submits that the response to the Appellant's argument has been address above in the regard to claim 22 (Response to C, number 1).

3. The Appellant argues claim 40 is patentable because the cited references do not teach or suggest the combination of elements recited therein, particularly the USPTO may not disregard claim limitations of printed matter. The Examiner respectfully disagrees. Campbell discloses, in addition to a monitor, a computer typically includes an output device such as a printer or speaker (Figure 2 and column 4, line 67 through column 5, line 2). The graphical user interface comprises screens for displaying the output (column 13, lines 60 – 65). It is inherent that a screen displayed on a computer can be printed, including the listing of the signs and symptoms exhibited by a patient (as disclosed by Campbell in column 4, lines 56 – 60) may be printed. Figures 3 - 7 of Campbell discloses patient identification data, descriptive information, signs and symptoms, listing of tests and treatments, and notes about the disorder. Tetrault was cited for manually recording information on a template (paragraph 10). USPTO need not give patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate (See: *In re Lowry*, 32 F.3d 1583-84, 32 USPQ2d and *In re Ngai*, 367, F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004)). The information on the template claimed by the Appellant is a listing of data used to evaluate a patient thus, it is not providing a new use of a template as it appears to be providing a method or guide for evaluation.

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4. The Appellant argues claim 41 is patentable because the cited references do not teach or suggest the combination of elements recited therein. The Examiner respectfully disagrees and submits that the response to the Appellant's argument has been address above in the regard to claim 40 (Response to E, number 3).

5. The Appellant argues claims 42 – 43 are patentable because the cited references do not teach or suggest the combination of elements recited therein. The Examiner respectfully disagrees and submits that the response to the Appellant's argument has been address above in the regard to claim 40 (Response to E, number 3).

6. The Appellant argues claim 46 is patentable because the cited references do not teach or suggest the combination of elements recited therein. The Examiner respectfully disagrees and submits that the response to the Appellant's argument has been address above in the regard to claim 40 (Response to E, number 3).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Kristine K Rapillo/

Examiner, Art Unit 3626

Conferees:

/Robert Morgan/
Supervisory Patent Examiner, Art Unit 3626

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